

REMARKS

Applicant has amended claims 13-14, 17, 24, and 27-28, and cancelled claims 1-12, 18, 20, and 29, during prosecution of this patent application. Applicant is not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

The Examiner rejected claims 13, 15, 17-26 and 28-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa (US 2005/0005097 A1) in view of Bhaskaran et al. (US 2005/0188203 A1 and Bhaskaran hereinafter).

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of Helpfile of Version 2.0 of MP3 Tag Clinic (XP-002334789 and Helpfile hereinafter).

The Examiner rejected claims 16 and 27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of DiPierro (US 2003/0088783 A1).

Applicant respectfully traverses the § 103 rejections with the following arguments.

35 U.S.C. § 103: Claims 13, 15, 17-26 and 28-32

The Examiner rejected claims 13, 15, 17-26 and 28-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa (US 2005/0005097 A1) in view of Bhaskaran et al. (US 2005/0188203 A1 and Bhaskaran hereinafter).

Since claims 18, 20, and 29 have been canceled, the rejection of claims 18 and 20 under 35 U.S.C. § 103(a) is moot.

Claims 13, 15, 17, 19, and 21-22

Applicant respectfully contends that claim 13 is not unpatentable over Murakawa in view of Bhaskaran, because Murakawa in view of Bhaskaran does not teach or suggest each and every feature of claim 13.

A first example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “a sender sending a request to a certification authority (CA) for a digital certificate; after said sending, said sender receiving from the certification authority (CA) who issued the digital certificate: a private key and a certificate address from which the digital certificate may be accessed, said private key being associated with the digital certificate”.

The Examiner argues: “Murakawa discloses ... receiving, from a certification authority (CA) (i.e. device) who issued a digital certificate, a private key associated with the digital certificate and a certificate address (i.e. list of certificates) from which the digital certificate may be accessed (0031, lines 1-3, 7-10)”

In response, Applicant asserts that Murakawa, Par. 0031, lines 1-10 discloses that a private key is provided in the web server of the device 100 and that the device 100 sends a digital certificate (i.e., a self-made certificate) to the client 200. Thus, the Examiner is arguing that device 100 represents the claimed certification authority from which the digital certificate is received by the client 200. Presumably, the Examiner considers the client 200 to be the sender. However, Murakawa, Par. 0031 does not disclose that the self-made certificate, a private key, and a certificate address (from which the digital certificate may be accessed) are sent by the certification authority (i.e., the device 100) to the sender (i.e., the client 200) who had previously sent a request for a digital certificate to the certification authority (i.e., the device 100).

As to the sender, Murakawa does not disclose that the sender (i.e., the client 200) sends a request to the certification authority (i.e., the device 100) for a digital certificate.

As to the private key, it is clear from Murakawa, FIG. 5 that both the root certificate and the self-made certificate at the device 100 include both a private key and a public key. However, it is also clear from Murakawa, FIG. 5 that only the public key and not the private key is received by the sender (i.e., client 200) from the device 100 for both the root certificate and the self-made certificate. Therefore, Murakawa does not disclose the sender (i.e., client 200) receiving a private key from a certification authority (CA) (i.e., the device 100) who issued a digital certificate, said sender (client 200) having previously requested a digital certificate from the certification authority (device 100).

As to the certificate address from which the digital certificate may be accessed, the Examiner argues that the list of certificates and the self-made certificate received by the client 200 from the device 100 satisfies the claim limitation of “receiving from the certification

authority (CA) who issued the digital certificate: ... a certificate address from which the digital certificate may be accessed". However, the disclosure in Murakawa, Par. 0031 of a list of certificates is not a disclosure of a certificate address from which the digital certificate may be accessed. Applicants assert that the list of certificates is mentioned in Murakawa, Par. 0031 in conjunction with a chain of certificates. Thus, the list of certificates that is sent by the device 100 to the sender (i.e., client 200) is an identification of the certificates that are in the chain of certificates. There is no disclosure in Murakawa, Par. 0031 the list of certificates include a certificate address from which the digital certificate may be accessed.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A second example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: "said sender generating a digital signature based on the file and the received private key".

The Examiner argues that Murakawa, Par. 0005, lines 21-22 and 24-28 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Murakawa, Par. 0005, lines 21-22 discloses that the sender (i.e., the client 200) generates the digital certificate based on a hash value and does not disclose that generation of the digital signature is based on the file and the received private key that had allegedly been received by the sender from the certification authority.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A third example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “encoding the received certificate address to generate an encoded address”.

The Examiner acknowledges that Murakawa does not disclose the preceding feature of claim 13, but argues that Bhaskaran, Par. 0017, lines 10-11 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Bhaskaran, Par. 0017, lines 10-11 discloses: “In FIG. 2, dynamic data 120 are shown as being encoded”. However, Bhaskaran, Par. 0017 does not disclose that the dynamic data 120 being encoded is a certificate address, as required by the preceding feature of claim 13. In fact, in Bhaskaran, FIG. 2, examples of the dynamic data 120 to be “settings, parameters, contract nos., order receipts, etc.” and are not stated to include a certificate address.

In “Response to Argument”, the Examiner argues: “Further as to claim 13, it is argued by the applicant that Bhaskaran does not disclose that the dynamic data being encoded is a certificate address. The examiner respectfully disagrees. Bhaskaran discloses that dynamic data may be contact phone numbers, settings, parameters, order receipts as well as other information such as software configuration information which is helpful to the end user or others (0014, lines6-9). It is noted that this list is non-limiting and it would have been obvious to one of

ordinary skill in the art at the time of the invention to use a location (i.e. information helpful to end user) as the dynamic data.”

In response, Applicants respectfully contend that the Examiner has erroneously argued that it is obvious to modify Bhaskaran by a feature of claim 13 that is unknown in the prior art. Applicants assert that a rejection of a claim on grounds of obviousness requires that all features of the claim are known in the prior art.

An attempt to show that it is obvious to combine elements to disclose the claimed invention starts with elements that are known in the prior art and then seeks to demonstrate that it is obvious to combine the elements. *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) (“When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine **known elements** in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. See Application of Bergel, 292 F.2d 955, 956-957 (1961)”) (emphasis added).

Insight as to why all elements of a claim must be known to reject the claim on grounds of obvious is provided in *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (reversing the Board’s rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: “**Obviousness cannot be predicated on what is unknown**””) (emphasis added).

Accordingly, the Examiner’s argument that it is obvious to modify Bhaskaran by a feature of claim 13 that is unknown in the prior art (i.e., the feature of “encoding the received certificate address to generate an encoded address”) is contrary to established patent law and thus not persuasive.

In addition, as to modifying Murakawa, the Examiner argues: “Bhaskaran recites motivation by disclosing that encoding information into a filename is an efficient way to add information to a software package without destroying the authentication or digital signature (0005, lines 1-3). It is obvious that the teachings of Bhaskaran would have improved the teachings of Bhaskaran by encoding information into a filename in order to add information to the file without destroying authentication information within the file.”

In response, Applicants assert that the preceding argument by the Examiner is not persuasive, because the preceding argument by the Examiner does not state motivation for encoding *specifically a certificate address* into a filename.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

A fourth example of why claim 13 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “merging the existing filename and the encoded address to generate a new filename; and renaming the file with the new filename”.

The Examiner acknowledges that Murakawa does not disclose the preceding feature of claim 13, but argues that Bhaskaran, Par. 0014, lines 13-16 disclose the preceding feature of claim 13.

In response, Applicant respectfully contends that Bhaskaran, Par. 0013, lines 11-13 discloses that the existing filename is “ProductX.exe” and Bhaskaran, Par. 0014, lines 13-16 disclose that the new filename is “ProductX_Y.exe” wherein Y is the dynamic data 120.

However, as explained *supra* in conjunction with the third example, Bhaskaran does not disclose that the dynamic data 120 being encoded is a certificate address which the Examiner has acknowledged.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 13.

Based on the preceding arguments, Applicant respectfully maintains that claim 13 is not unpatentable over Murakawa and in view of Bhaskaran, and that claim 13 is in condition for allowance. Since claims 15, 17, 19, and 21-22 depend from claim 13, Applicant contends that claims 15, 17, 19, and 21-22 are likewise in condition for allowance.

In addition with respect to claims 17 and 28, Murakawa and in view of Bhaskaran does not disclose the feature: “wherein the method further comprises sending the renamed file from an owner of the digital certificate to a user” (claim 17) and “wherein the method further comprises: prior to said extracting, receiving the file from an owner of the digital certificate” (claim 28).

The Examiner argues: “Bhaskaran discloses: **sending the renamed (i.e. wrapped) file from an owner (i.e. distributor) of the digital certificate to a user** (0019, lines 10-12).”

In response, Applicants assert that Bhaskaran does not disclose that a distributor of the digital certificate is an owner of the digital certificate, as required by the preceding feature of claims 17 and 28. Therefore, the preceding argument by the Examiner is not persuasive.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claims 17 and 28.

In addition with respect to claim 19, Murakawa and in view of Bhaskaran does not disclose the feature: “wherein the certificate address is an address of a server of the certification authority”.

The Examiner argues that Murakawa, Par. 0029, lines 14-15 and Par. 0041, lines 7-9 disclose the preceding feature of claim 19.

In response, Applicant asserts that the “certificate address” in claim 19 has antecedent basis in “certificate address” in claim 13. Therefore, the recited certificate address in claim 19 is required to be the same the certificate address as in claim 13, which is alleged by the Examiner to be the “list of certificates” recited in Murakawa, Par. 0031. Furthermore, the Examiner has argued in conjunction with claim 13 that the certification authority is the device 100 in Murakawa. Applicants assert that there is no disclosure in Murakawa, Par. 0029, lines 14-15 and Par. 0041, lines 7-9, or anywhere else in Murakawa, that the list of certificates recited in Murakawa, Par. 0031 is an address of a server of the device 100 as required by claim 19.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 19.

Claims 23-26, 28, and 30-32

Applicant respectfully contend that claim 23 is not unpatentable over Murakawa and in view of Bhaskaran, because Murakawa and in view of Bhaskaran does not teach or suggest each and every feature of claim 23.

A first example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “extracting the encoded address from the filename”.

The Examiner argues: “Murakawa discloses: **extracting the encoded address from the filename** (0015, lines 15-17). Given the teaching of Bhaskaran, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Murakawa with the teachings of Bhaskaran by extracting an address from the filename. Please refer to the motivation recited above in respect to claim 13 as to why it is obvious to apply the teachings of Bhaskaran to the teachings of Murakawa.”

In response, Applicants assert that Bhaskaran, Par. 0015, lines 15-17 recite: “The user then reads the new filename to extract this text which may include dynamic data such as settings, parameters, contact numbers, order receipts, etc.”

Applicants assert that Bhaskaran, Par. 0015, lines 15-17 does not disclose that the dynamic data includes an encoded address. Since the Examiner cannot find any prior art allegedly disclosing a filename that includes an encoded address, the Examiner cannot make an argument that it is obvious to modify Bhaskaran to include an encoded address in the dynamic data in the filename, as discussed *supra* in conjunction with the cases of *KSR Int’l Co. v. Teleflex Inc.* and *In re Shetty*.

Moreover, the Examiner’s statement “Please refer to the motivation recited above in respect to claim 13 as to why it is obvious to apply the teachings of Bhaskaran to the teachings of Murakawa” is not persuasive, because the Examiner’s argument for claim 13 stated motivation to

encode information into a filename, which is not relevant to the preceding feature of claim 23 of “extracting the encoded address from the filename”.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

A second example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: “decoding the extracted encoded address to generate a certificate address from which a digital certificate may be accessed”.

The Examiner argues that Murakawa, Par. 0031, lines 10-14 and Par. 0042, lines 6-8 disclose the preceding feature of claim 23.

In response, Applicant respectively contends that Murakawa, Par. 0031, lines 10-14 disclose decrypting a certificate but does not disclose decoding an address, as required by the preceding feature of claim 13, and Murakawa, Par. 0031, lines 10-14 most certainly does not disclose decoding an encoded address that has been extracted from a filename, as required by the preceding feature of claim 13.

In further response, Applicant notes that Murakawa, Par.0042, lines 6-8 recites “a certificate at the high level (the root certificate in this example) is acquired based on the information in the certificate (S40)”, which is unrelated to the preceding feature of claim 23.

Furthermore, Murakawa, Par. 0031, lines 10-14 and Par. 0042, lines 6-8 does not disclose generating a certificate address from which a digital certificate may be accessed, as required by the preceding feature of claim 23.

In "Response to Arguments", the Examiner argues: "As to claim 23, it is argued by the applicant that Murakawa does not disclose generating a certificate address from which a digital certificate may be accessed. The examiner respectfully disagrees. Murakawa discloses that a certificate is acquired based on the information in the certificate (i.e. location) and that the information is inputted (i.e. generated) by a user (0041, lines 3-4, 6-8)."

In response, Applicants assert that the preceding argument by the Examiner based on Murakawa, Par. 0041, lines 3-8 relates to generating a certificate based on user input, but does not relate to generating a certificate address from which a digital certificate may be accessed as required by the preceding feature of claim 23.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

A third example of why claim 23 is not unpatentable over Murakawa in view of Bhaskaran is that Murakawa in view of Bhaskaran does not teach or suggest the feature: "accessing the digital certificate from the generated certificate address" in combination with "extracting the encoded address from the filename; decoding the extracted encoded address to generate a certificate address".

The Examiner argues that Murakawa, Par. 0042, lines 6-8 disclose the preceding feature of claim 23. In particular, the Advisory Action mailed 05/26/2009 argues: "Murakawa discloses that a certificate is created (i.e. generated) by having a user input information and including the path information (i.e. address) of the high levels of the certificate (0041, lines 1-9). Murakawa

also discloses that the certificate at the high level (i.e. at the path information, address) is acquired (i.e. accessed) (0042, lines 6-8).”

In response, Applicant notes that the preceding feature of claim 23 requires accessing the digital certificate from a certificate address that had been generated by decoding an encoded address that had been extracted from a file name.

In contrast, the Examiner argues that Murakawa discloses accessing the digital certificate from a certificate address that had been extracted from the digital certificate.

Since the certificate address used to access the digital certificate is required by claim 23 to have been extracted from a filename in which the certificate address had been encoded, and since the Examiner argues that the certificate address used to access the digital certificate is extracted in Murakawa from the digital certificate rather from a filename in which the certificate address had been encoded, Applicant respectfully contends that the Examiner’s argument is not persuasive.

Therefore, Murakawa in view of Bhaskaran does not disclose the preceding feature of claim 23.

Based on the preceding arguments, Applicants respectfully maintain that claim 23 is not unpatentable over Murakawa and in view of Bhaskaran, and that claim 23 is in condition for allowance. Since claims 24-26, 28, and 30-32 depend from claim 23, Applicants contend that claims 24-26, 28, and 30-32 are likewise in condition for allowance.

35 U.S.C. § 103(a): Claim 14

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of Helpfile of Version 2.0 of MP3 Tag Clinic (XP-002334789 and Helpfile hereinafter).

Since claim 14 depends from claim 13 which Applicants have argued *supra* to not be unpatentable over Murakawa in view of Bhaskaran under 35 U.S.C. §103(a), Applicants maintain that claim 14 is likewise not unpatentable over Murakawa in view of Bhaskaran, and further in view of Helpfile under 35 U.S.C. §103(a).

35 U.S.C. § 103(a): Claims 16 and 27

The Examiner rejected claims 16 and 27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Murakawa in view of Bhaskaran as applied to claim 13 above, and further in view of DiPierro (US 2003/0088783 A1).

Since claims 16 and 27 depend from claims 13 and 23, respectively, which Applicants have argued *supra* to not be unpatentable over Murakawa in view of Bhaskaran under 35 U.S.C. §103(a), Applicants maintain that claims 16 and 27 are likewise not unpatentable over Murakawa in view of Bhaskaran, and further in view of DiPierro under 35 U.S.C. §103(a).

In addition with respect to claims 16 and 27, Murakawa in view of Bhaskaran, and further in view of DiPierro does not disclose the feature: “wherein the file comprises a document, wherein said signing the file comprises appending the generated digital signature to the file such that the generated digital signature is disposed between a beginning tag and an ending tag at the beginning of the file before the document”.

The Examiner argues that DiPierro, Par. 0039, lines 2-3 discloses the preceding feature of claims 16 and 27.

In response, Applicants note that DiPierro, Par. 0039, lines 1-3 recites: “One embodiment of the invention uses an algorithm to generate a digital signature for authentication, stores that digital signature in the file header or otherwise with the file, and then encrypts the digital signature together with the data in the file.”

Although DiPierro, Par. 0039, lines 1-3 discloses that the generated digital signature is disposed in the file header, DiPierro, Par. 0039, lines 1-3 does not disclose that the generated digital signature is disposed in the file header between a beginning tag and an ending tag.

Therefore, claims 16 and 27 are not unpatentable over Murakawa in view of Bhaskaran,
and further in view of DiPierro

CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM).

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